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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|-------------------|
| 10/697,052 | 10/31/2003 | Paul Geoffrey Brown | ARC920030044US1 | 8380 |
| 26381 | 7590 | 09/20/2006 | EXAMINER | |
| LACASSE & ASSOCIATES, LLC 1725 DUKE STREET SUITE 650 ALEXANDRIA, VA 22314 | | | | COUGHLAN, PETER D |
| ART UNIT | | PAPER NUMBER | | |
| | | 2129 | | |

DATE MAILED: 09/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|----------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/697,052 | BROWN ET AL. |
| | Examiner Peter Coughlan | Art Unit 2129 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 29 June 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-10, 12, 13, 16, 17 and 22-24 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-10, 12, 13, 16, 17 and 22-24 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 10/31/2003 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

Detailed Action

1. This office action is in response to an AMENDMENT entered June 29, 2006 for the patent application 10/697052 filed on October 31, 2003.
2. The First Office Action of June 7, 2006 is fully incorporated into this Final Office Action by reference.
3. The Detailed Action dated May 23, 2006 rejected all claims (1-38) under 35 U.S.C. §101, rejected claims 1-10, 16, 18, 20, 22-31 and 34-38 under 35 U.S.C. §102(b), and rejected claims 17, 32, and 33 under 35 U.S.C. §103(a). Form PTOL-376 at items 5 and 6 of the office action dated May 23, 2006 incorrectly summarized such action. Item 5 is corrected to read claims 1-38 are rejected.
4. One recommendation for possible allowance is the following. The phrase 'to perform query optimization by automatically finding and exploiting hidden, fuzzy algebraic constraints' is an exercise at best. How does one exploit hidden fuzzy algebraic constraints and what are the benefits of doing so? To be granted an

allowance the process as stated in the current claims must be embodied in a practical application to surpass the 35 U.S.C. 101 requirements.

Status of Claims

5. Claims 1-10, 12, 13, 16, 17, 22, 23, 24 are pending.

35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-10, 12, 13, 16, 17, 22, 23, 24 are rejected under 35 U.S.C. 101 for nonstatutory subject matter. The computer system must set forth a practical application of that § 101 judicial exception to produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77. The invention is a process for optimizing a query. No benefits or applications of this process is stated in the claims. The result has to be a practical application. Please see the interim guidelines for examination of patent applications for patent subject matter eligibility published November 22, 2005 in the official gazette.

In determining whether the claim is for a "practical application," the focus is not on whether the steps taken to achieve a particular result are useful, tangible and

concrete, but rather that the final result achieved by the claimed invention is “useful, tangible and concrete.” If the claim is directed to a practical application of the § 101 judicial exception producing a result tied to the physical world that does not preempt the judicial exception, then the claim meets the statutory requirement of 35 U.S.C. § 101. What purpose does finding and exploiting hidden, fuzzy algebraic constraints if view of real world functionality.

The invention must be for a practical application and either:

- 1) specify transforming (physical thing) or
- 2) have the FINAL RESULT (not the steps) achieve or produce a useful (specific, substantial, AND credible),
concrete (substantially repeatable/ non-unpredictable), AND
tangible (real world/ non-abstract) result.

A claim that is so broad that it reads on both statutory and non-statutory subject matter, must be amended, and if the specification discloses a practical application but the claim is broader than the disclosure such that it does not require the practical application, then the claim must be amended.

The claims in their current version still map to an abstract algorithm without a practical use or purpose and thus are not statutory.

Response to Arguments

7. Regarding response dated June 29, 2006 page 10, line 8, 'Claims 11-15, 19 and 21 are allowed," such claims were rejected, see paragraph 3 above.

8. Applicant's arguments filed on June 29, 2006 for claims 1-10, 12, 13, 16, 17, 22, 23, 24 have been fully considered but are not persuasive.

9. In reference to the Applicant's argument:

Claims 1-38 are rejected under 35 U.S.C. 101 for non-statutory subject matter. As per Examiner's suggestion during the interview of 6/27/2006, Applicants have amended the preamble of claims 1 and 22 without adding new matter. Objections with respect to claims 11, 14-15, 18-21, and 25-38 are moot in light of their cancellation via the current amendment. Applicants respectfully request the Examiner to remove the 35 U.S.C. 101 rejection with regards to claims 1-10, 12-13, 16-17, and 22-24.

Examiner's response:

Applicant has failed to provide a purpose, function, or application in regards to a real world benefit of the invention. Non-final Office Action stands.

10. In reference to the Applicant's argument:

Claims 1 and 22 have been rewritten with the limitations with the limitations of claim 11 which was indicated as allowable. Applicants hereby request the Examiner to withdraw the 35 U.S.C. 102 and 103 rejections and hereby request allowance of pending claims.

It should be noted that although claims 1 and 22 have been amended to incorporate allowable claim language, it is by no means a statement by the applicants that previously pending were anticipated or rendered obvious by the art of record.

Examiner's response:

Based on the amended claims the Examiner withdraws 35 U.S.C. 102 and 103 rejections.

Examination Considerations

11. The claims and only the claims form the metes and bounds of the invention. "Office personnel are to give the claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d, 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969)" (MPEP p 2100-8, c 2, I 45-48; p 2100-9, c 1, I 1-4). The Examiner has the full latitude to interpret each claim in the broadest reasonable sense. Examiner will reference prior art using terminology familiar to one of ordinary skill in the art. Such an approach is broad in concept and can be either explicit or implicit in meaning.

12. Examiner's Notes are provided to assist the applicant to better understand the nature of the prior art, application of such prior art and, as appropriate, to further indicate other prior art that maybe applied in other office actions. Such comments are entirely consistent with the intent and spirit of compact prosecution. However, and unless otherwise stated, the Examiner's Notes are not prior art but link to prior art that one of ordinary skill in the art would find inherently appropriate.

13. Examiner's Opinion: Paragraphs 11 and 12 apply. The Examiner has full latitude to interpret each claim in the broadest reasonable sense.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Claims 1-10, 12, 13, 16, 17, 22, 23, 24 are rejected.

Correspondence Information

16. Any inquiry concerning this information or related to the subject disclosure should be directed to the Examiner Peter Coughlan, whose telephone number is (571) 272-5990. The Examiner can be reached on Monday through Friday from 7:15 a.m. to 3:45 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor David Vincent can be reached at (571) 272-3687. Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks,
Washington, D. C. 20231;

Hand delivered to:

Receptionist,
Customer Service Window,
Randolph Building,
401 Dulany Street,
Alexandria, Virginia 22313,
(located on the first floor of the south side of the Randolph Building);

or faxed to:

(571) 273-8300 (for formal communications intended for entry.)

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).



Peter Coughlan

9/13/2006



DAVID VINCENT,
SUPERVISORY PATENT EXAMINER